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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,179	11/13/2001	Etienne Grange	1352-01	7779
35811	7590	04/07/2006	EXAMINER	
IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP			MANNING, JOHN	
1650 MARKET ST			ART UNIT	
SUITE 4900			PAPER NUMBER	
PHILADELPHIA, PA 19103			2623	
DATE MAILED: 04/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/010,179		GRANGE ET AL.	
	Examiner		Art Unit	
	John Manning		2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on n/a is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The lack of drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed limitations must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 2-4 objected to because of the following informalities:

Claim 2-4 recites the limitation "**the** activation signal" and "**the** continuous program". There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 9 recites "IT communication means" and the specification merely recites the term "IT communication means" with no explanation or description that would reasonably convey to one skilled in the art the what type of communications means is being used.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Picco et al. (US Pat No 6,029,045).

In regard to claim 1, the claimed step of "transmitting a first video signal corresponding to a main program comprising video advertising slots interpolated between video slots" is met by Figure 4, Item 106. "As shown, the live television programming data feeds 106 and the local content feeds 108 are multiplexed by a multiplexer (MUX) 140 into a compressed digital data stream having a format of an MPTS" (Col 6, Lines 46-50). The claimed step of "a second video signal corresponding to an optional advertising program" is met by Figure 4, Item 108. The claimed steps of "comprising a sequence triggering recording in a temporary high-speed memory" and "recording the second signal in a temporary high-speed memory upon detection of said triggering sequence" are met by Figure 4, Item 148 and Figure 7, Item 186. "Thus, the set-top box may use these coefficients to determine which pieces of local content are going to be stored by each particular set-top box and which stored pieces of local content are going to be inserted into a live feed signal by a particular set-top box. In accordance with the invention, the pieces of local content downloaded to the set-top box may have a plurality of different content profiles and only the pieces of local content with content profiles that match some predetermined criteria stored in the set-top box are stored in the set-top box. Then, the local content space in the programming data may

include control data which indicates which type of local content may be inserted in that particular local content space. The set-top box then uses the control data in the local content space to determine which piece of stored local content data is inserted into the programming data stream” (Col 8, Lines 7-22; Also see: Col 7, Line 33 – Col 8, Line 6). The claimed step of “substantially continuously transmitting the first signal to a display circuit” is met by Figure 7. “Thus, in addition to the conventional live feeds and local content, the combiner may combine a plurality of user-specific information in the satellite signal including a private data identification code that permits the set-top box in accordance with the invention to locate the private data being transmitted through the satellite in accordance with the invention. The private data may include the compressed local content, as described above, which may be transmitted to each set-top box using several different transmission strategies, as described below. This local content may not be transmitted in real-time in that the local content is not immediately viewed by the user of the set-top box since the set-top box inserts the local content into the satellite signals as needed. As described above, the private data may also include command and control data that instructs the processor within the set-top box how to insert the local content into the satellite data streams” (Col 8, Lines 23-39). The claimed step of “the first signal comprises graphic signaling means for activating retrieval of the video signals stored in the memory and the second signal is loaded in the memory upon receive initialization” is met by Figure 7. “When controlling the disk, the set-top box may control the pieces of local content that are stored on the disk based on the control data, control the pieces of local content that are actually inserted into a programming data

stream, and manage the real-time performance of the disk, including determining which local content may be overwritten or removed. The set-top box in accordance with the invention also performs other disk control operations, such as ensuring that the data stored on the disk is not fragmented” (Col 9, Line 62 – Col 10, Line 4).

In regard to claim 2, Picco discloses the triggering sequence and the activation signal identifier are correlated in that both are phenomena that accompany another phenomenon.

Claims 3 and 4 are met by that discussed for claim 1.

In regard to claim 8, the claimed limitations of “interactive advertising sequences according to claim 1”, “a high-speed local memory connected to a demultiplexer” and “high-speed memory content display means and means for triggering the high-speed memory content display” are met by Figure 7 (See Col 10, Lines 34 – Col 11, Lines 17).

In regard to claim 9, Picco discloses communication means allowing the transmission of view-related data (See Figure 4, Item 152).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al.

In regard to claims 5-6, Picco fails to explicitly disclose the retrieved video signal is superimposed on the continuous program. The Examiner takes Official Notice that it is notoriously well known in the art to superimpose a retrieved video signal on a continuous program so as to constantly expose a user to advertisements. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Picco with superimposing a retrieved video signal on a continuous program for the stated advantage.

In regard to claim 7, Picco discloses that the retrieval activation by a test of the presence of the signaling means but fails to explicitly disclose retrieval activation by the activation of remote control means. However, the Examiner takes Official Notice that it is notoriously well known in the art to have retrieval activation by the activation of remote control means so as to allow the user to interact with the system. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Picco with retrieval activation by the activation of remote control means for the stated advantage.

In regard to claim 10, Picco fails to explicitly disclose secure payment means, however, the Examiner takes Official Notice that it is notoriously well known in the art to have secure payment means so as to allow the user to allow the user to safely purchase items from their home. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Picco with secure payment means for the stated advantage.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Zigmond et al. (US Pat No 6,698,020)
- Hite et al. (US Pat No 5,774,170)
- Jernigan et al. (US Pat No 5,233,423)

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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April 3, 2006



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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600